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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------|
| 10/022,153   | 12/14/2001  | Steven W. Lundberg   | 684.001US2                    | 5885             |
| 21186  | 7590        | 02/10/2006           |                               |                  |
| SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH<br>1600 TCF TOWER<br>121 SOUTH EIGHT STREET<br>MINNEAPOLIS, MN 55402 |             |                      | EXAMINER<br>KOPPIKAR, VIVEK D |                  |
|  |             |                      | ART UNIT                      | PAPER NUMBER     |
|  |             |                      | 3626                          |                  |
| DATE MAILED: 02/10/2006  |             |                      |                               |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/022,153

Applicant(s)

LUNDBERG, STEVEN W.

Examiner

Vivek D. Koppikar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 52-293 is/are pending in the application.
- 4a) Of the above claim(s) 53-58, 60, 62-67, 69-165, 167-172, and 175-293 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52, 59, 61, 68, 166, 173 and 174 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date all received.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Application***

1. Claims 52, 59, 61, 68, 166, 173 and 174 have been examined in this application. The Information Disclosure Statement (IDS) statements filed on December 14, 2001; August 9, 2004 and February 11, 2005 have also been acknowledged.

### ***Election/Restrictions***

2. On August 12, 2005 applicants filed a response to the restriction requirement mailed on December 8, 2004. This election requirement was incorrect. On January 27, 2006, the counsel for applicants orally elected to prosecute Claims 52, 59, 61, 68, 166, 173 and 174. The other pending claims in this application are withdrawn from consideration.

### ***Claim Objections***

3. Claim 52 is objected to because of the following informalities: There should be an "on" between "based" and "a" on line 13 of claim 52. Claim 166 is objected to for the same reason.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 52, 59, 61, 68, 166, 173, and 174 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,649, 177 to Landry.

(A) As per claim 52, Landry teaches a system having at least one first account (payor account) for paying at least some expenses incurred (Landry: Col. 6, Ln. 34-54);

using at least one second account to pay out-of-pocket costs (bills) incurred wherein at least some of the out-of-pocket costs are financed, and payments are specified for payment for payment using a computer (bill generator) (Landry: Col. 6, Ln. 30-54, Col. 6, Ln. 64-Col. 7, Ln. 5 and Col. 35, Ln. 36-58);

determining, using a computer, an associated expense for each of at least some of the financed out-of-pocket costs, wherein the associated expense

i) includes a finance charge that is at least in part dependent on financing the out-of-pocket cost for a period of time, wherein the period of time at least in part includes a portion that occurs after the date of invoicing the client for the respective out-of-pocket costs (Landry: Col. 35, Ln. 36-58 and Col. 36, Ln. 46-51);

ii) and is determined substantially at the same time the corresponding out-of-pocket cost is specified to be paid (Landry: Col. 35, Ln. 36-58 and Col. 6, Ln. 47-51).

billing, using a computer, the one or more clients of the law firm for at least some of the financed out-of-pocket costs and for the associated expenses corresponding to the at least some out-of-pocket costs, wherein the billing for corresponding out-of-pocket costs and associated expenses are presented in the same invoice (Landry: Col. 35, Ln. 36-58).

Landry does not teach that the billing system is used by a law firm to pay the out-of-pocket expenses of clients. Landry does state that a motivation for using this system is to eliminate the necessity for multiple payees to make delivery of their respective bills to consumer payors and to allow the possibility of single delivery of bills from multiple payees to a payor. Based on this intended use of Landry the examiner takes Official Notice that, at the time of the invention, it would have been obvious for one of ordinary skill in the art to have employed the

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system of Landry in a law firm for the motivation stated above. At the time of the invention, a law firm would have implemented this system to pay the multiple payees of clients (e.g. Patent and Trademark Office, photocopying services, drawing generation services) and deliver these bills (in the form of one invoice covering all the expenses incurred for the payor) to the payor

Landry does not teach that the finance charge is dependent, in part, upon the duration of the period of time between billing and collection for the law firm, however, the examiner takes Official Notice that this factor is taken into account when calculating a finance or service charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have used this factor in calculated the finance charged owned by the payor (client) with the motivation of being able to recover interest on the uncollected portion of the balance from the client.

(B) As per claim 59, in the method of Landry the step of specifying the payment of the out-of-pocket costs comprises requesting that the out-of-pocket cost be paid at a future time (Landry: Col. 36, Ln. 24-51).

(C) As per claim 61, in the method of Landry the substantially at the same time comprises the same month (or day) the out-of-pocket cost was arranged to be paid in (Landry: Col. 35, Ln. 18-36).

(E) As per claims 68, 166, 173 and 174, these claims repeat features previously addressed in the rejection of claims 52, 59 and 61 and are rejected on the same basis.

*Conclusion*

6. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone number for this group is (703) 872-9326 (for official communications including After Final communications labeled "Box AF").


Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,



Vivek Koppikar

1/27/2006



C. LUKE GILLIGAN  
PATENT EXAMINER